

Remarks

Claim Rejections - 35 USC §112

In response to the examiner's rejection under 35 USC §112, claims 20 and 31 are herewith amended to delete the "no midsole" language. As thus amended, the claims are believed to fully comply with 35 USC §112.

Allowable Subject Matter - Claims 26, 27 and 31

Claims 26, 27 and 31 were rejected in the Office action only under 35 USC §112. As to claim 31, this claim, as currently amended should now be in condition for allowance. Claims 26 and 27 are not rewritten in independent form because they depend from claim 20 which is believed to be patentable over the cited art for the reasons explained below.

Claim Rejections - 35 USC §102

Applicant respectfully disagrees with Examiner that claims 20-22, 24 and 25 are anticipated by U.S. Patent 5,896,682 (Lin).

Currently amended claim 20 is directed to footwear comprising, *inter alia*, the following:

an insert being sized and shaped to overlies the outsole in at least part of the lateral region of the heel section of the outsole, at least part of the lateral region of the arch section of the outsole, and the first region of the forefoot section for attenuating the shock of impact in these regions during running and walking, and said insert being sized and shaped not to overlies at least part of the medial region of the arch section of the outsole and the second region of the forefoot section of the outsole whereby the outsole provides firmer foot support in these regions during walking and running.

The first region of the forefoot section of the outsole, emphasized above, is defined in the claim as supporting the first, second, third, fourth, and fifth metatarsal heads,

associated phalanges and metatarsal phalangeal joints. Applicant's claimed insert overlies this region. The claim further specifies that the insert does not overlie, *inter alia*, the second region of the forefoot section of the outsole, which is specified in the claim as supporting at least one of the metatarsal necks associated with the second and third metatarsal heads. This configuration is important not only for cushioning the foot, but also for allowing proper movement of the bones of the foot relative to one another, as explained in the application (see, e.g., page 2, and the paragraph bridging pages 10 and 11 of the application).

Lin is directed to an insert (10) placed on an outsole (30). The insert is disclosed as being a shock-absorbing rib with two flexible water chambers (11,11') and a water passage (12) in communication with the chambers. The insert (10) is assembled with an insole (20) by inserting the chambers (11,11') into holes (21,21') from the bottom of the insole. There is no discussion in the text of the patent about the specific placement of the insert (10) relative to the foot, and the drawings fail to show the precise location of the insert relative to the specific bones of a foot.

Thus, Lin clearly fails to show or suggest an insert which overlies the specific regions of the outsole recited in claim 20 (i.e., the regions supporting the first, second, third, fourth, and fifth metatarsal heads, associated phalanges and metatarsal phalangeal joints). Nor does Lin disclose an insert which does not overlie other specific regions of the outsole as recited in claim 20 (i.e., the regions supporting at least one of the metatarsal necks associated with the second and third metatarsal heads). On the contrary, based on the drawings of the Lin patent it appears that the shock-absorbing rib underlies only the central portion of the foot, not the claimed lateral regions, and further that the rib does not underlie all five metatarsal heads, as claimed. (Lin's shock-absorbing rib would appear to underlie metatarsal heads 2-4, at most.) As noted above, the specific

configuration of applicant's insert is important not only for cushioning the foot but also for permitting proper movement of bones of the foot during walking and running. Applicant's specific design achieves both results. There is insufficient detail and disclosure in Lin to either disclose or suggest Applicant's design. Indeed, any teaching based on the Lin patent appears to be away from the specific construction of Applicant's claimed insert, as noted above. Further, Lin discusses only cushioning of the foot. There is no discussion or consideration of proper bone movement, and thus no teaching of Applicant's invention.

The undersigned would like to emphasize that the drawings of a reference can anticipate claims only if they clearly show the structure which is claimed. MPEP 2125 (2003) citing *In re Mraz*, 455 F.2d 1069, 173 U.S.P.Q. 25 (CCPA 1972). Lin does not clearly show the insert overlying the regions of the outsole that support the lateral regions of the foot, and all five metatarsal heads, phalanges and metatarsal phalangeal joints. Similarly, Lin does not clearly show the insert as not overlying the regions of the outsole that support at least one of the metatarsal necks of the second and third metatarsal heads. Nor would Lin's drawings suggest applicant's claimed invention to one of ordinary skill in the art, since there is no disclosure in the reference regarding the need for proper bone movement during running and walking, and thus no teaching of how to configure an insert to be allow such movement.

Because Lin does not disclose every element of claim 20, claim 20 is not anticipated.

Claims 21, 22, 24 and 25, which depend either directly or indirectly from claim 20, are not anticipated for at least the same reasons as claim 20.

#### Claim Rejections - 35 U.S.C. §103

Applicant respectfully disagrees with Examiner that claims 23 and 28-30 are unpatentable under 35 U.S.C. §103 in view of Lin

alone or in combination with either U.S. Patent 2,707,340 (Scala) or U.S. Patent No. 4,519,147 (Jones, Jr.). Neither Scala nor Jones, Jr. add anything to Lin regarding the configuration of Applicant's claimed insert. In this regard, neither reference discloses an insert even remotely similar to Applicant's claimed insert.

Therefore, claims 23 and 28-30 are believed to be patentable and non-obvious over the prior art for the same reasons discussed above regarding claim 1.

Terminal Disclaimer

In an effort to avoid any possible double patenting rejection based on co-assigned U.S. Patent Nos. 5,787,610 and 5,964,046, applicant submits herewith a terminal disclaimer in compliance with 37 CFR 1.321(c). An assignment to Jeffrey S. Brooks, Inc. (copy enclosed) is also being recorded.

3.73(b) Certificate

To establish that assignee Jeffrey S. Brooks, Inc. has ownership of the application and authority to submit the terminal disclaimer, applicant submits herewith a 3.73(b) certificate.

CONCLUSION

In view of the foregoing, this application is now believed to be in condition for allowance.

Respectfully submitted,

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